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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/731,283	12/09/2003	James B. Brauer	STL11646	4908

7590 09/28/2006
Seagate Technology LLC
1280 Disc Drive
Shakopee, MN 55379

EXAMINER

BAE, JI H

ART UNIT	PAPER NUMBER
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2115.

DATE MAILED: 09/28/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/731,283	BRAUER, JAMES B.	
	Examiner	Art Unit	
	Ji H. Bae	2115	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-27 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-27 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

Applicant's arguments filed on 19 July 2006 have been fully considered but they are not persuasive.

The prior office action rejected claims 1-27 under 35 U.S.C. 101 as directed towards non-statutory subject matter. In response, applicant filed a detailed defense as to why the claims are statutory. The examiner believes that most of the applicant's arguments are not relevant to the issue at hand, save for that presented on pages 18-19, "The practical application of the claimed invention produces a useful, concrete, and tangible result."

The examiner cites the following portion of applicant's claim:

"... selecting a power management timer setting from the range of power management timer settings based on the estimated energy value to complete the series of tasks for each of the plurality of settings within the range of settings" [claim 1, lines 9-11].

The examiner maintains the original grounds for rejection, specifically that the claims do not produce a useful, concrete, and tangible result. From the language of the claim, it appears to the examiner that the last step of the method is a **selection of a value. Thus, the result of the method as claimed is nothing more than a numerical value. Applicant's claim does not include limitations that actually describe the application of that numerical value to produce some useful, concrete, tangible result.** If, for example, applicant had added an additional limitation which claimed that the selected numerical value is applied towards some machine or process which results in some tangible result or product, then applicant's claims would be statutory. But as the claims are currently written, there are no such additional limitations. Therefore, the examiner is forced to conclude that the result is not useful (because

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a numerical value alone lacks utility unless applied towards something), nor is it tangible (since a numerical value is nothing more than an abstract concept).

The examiner notes further that, since the method implemented by the system and instructions on a machine readable medium (claims 10 and 19) is similar in scope to that of claim 1, claims 10 and 19 are also non-statutory. The system and machine readable instructions also do not produce a useful, concrete, and tangible result.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-27 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-27 recite steps for selecting a power management timer setting from a range of power management timer settings. As recited, the claims merely present a series of steps/computations without a useful, concrete, and tangible result. In particular, the result of the recited steps is merely a selection of a value based on a series of calculations/comparisons. Since there is no recitation of any subsequent steps that show the result of the selection step being used to perform some task that results in a useful, concrete, tangible result, the claims are judged to be non-statutory.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ji H. Bae whose telephone number is 571-272-7181. The examiner can normally be reached on Monday-Friday, 10 am to 6:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas Lee can be reached on 571-272-3667. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Ji H. Bae

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Patent Examiner

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ji.bae@uspto.gov

571-272-7181

A handwritten signature in black ink, consisting of a series of loops and a trailing horizontal line.